

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK AND TRIAL APPEAL BOARD

Applicant: Quad/Graphics, Inc.

Mark: IMPOZE

Serial No.: 78/079,036

Filed: August 14, 2001

Law Office No. 102

Examining Attorney: Michael Webster

I, Joyce Early, hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail on the date of my signature and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Date: 9-27-04

**APPLICANT'S NOTICE OF APPEAL TO  
EXAMINING ATTORNEY'S FINAL REJECTION**

Box TTAB  
FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration. Pursuant to 37 CFR 26(a)(18), Applicant submits herewith the filing fee of \$100.00 for the class covered in this application. Please charge additional fees or credit any overpayment to Deposit Account No. 13-3080.

Applicant has also submitted a Request for Reconsideration to the Examining Attorney in charge of this case. As can be seen, Applicant wishes to submit additional evidence for consideration by the Examining Attorney. Therefore, pursuant to 37 C.F.R. § 2.142(d) and TBMP §1203.02(a), Applicant asks that the Board suspend further proceedings with respect to this appeal pending the disposition of Applicant's Request for Reconsideration to allow the

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Examining Attorney to consider the additional evidence. Should the Examining Attorney continue the refusal of registration after review of Applicant's Request for Reconsideration, Applicant understands that the Board will then reinstate the appeal and allow Applicant time to prepare and file a brief in support of its Notice of Appeal.

Applicant respectfully requests that the Board acknowledge receipt of Applicant's Notice of Appeal and suspend further proceedings pending the outcome of Applicant's Request for Reconsideration.

Dated this 27<sup>th</sup> day of September, 2004.

**MICHAEL BEST & FRIEDRICH LLP**  
Attorneys for Applicant

By:   
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Atty. Ref.: 077047/9439

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Date: \_\_\_\_\_

*Joyce Early*  
9-27-04

**RESPONSE AND REQUEST FOR RECONSIDERATION**

Commissioner for Trademarks  
**Box RESPONSES—Law Office 102 - NO FEE**  
2900 Crystal Drive  
Arlington, VA 22202-3514

Applicant hereby responds to Office Action No. 2 dated April 22, 2004.

**REQUEST FOR RECONSIDERATION - Descriptiveness**

Applicant wishes to submit additional evidence and arguments, which it believes, will establish that the final rejection should be withdrawn, and this application should be passed to publication. Therefore, Applicant submits this Request for Reconsideration pursuant to TMEP § 1105.04(f). Applicant has also submitted a Notice of Appeal directly to the Trademark Trial and Appeal Board. Applicant has requested suspension of the appeal pending the outcome of this Request for Reconsideration.

The Examining Attorney has refused registration on the basis that Applicant's mark IMPOZE is merely descriptive of "planning and information management software for magazine makeup and production for use in the printing and publishing industries in International Class 9."

It is submitted that IMPOZE is at most suggestive in that it would require imagination, thought and perception to reach a conclusion from that term as to the nature of Applicant's goods. See generally Application of Abcor Development Corp., 588 F.2d 811 (C.C.P.A. 1978); Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc., 561 F. Supp. 1014 (D.R.I. 1983) (RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held a protractible suggestive term). No definite or precise meaning comes to mind when one uses the term "IMPOZE;" the term is somewhat ambiguous, and a purchaser would have to engage in thought and reasoning to ascribe any meaning to it. Thus, while the mark may "through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of applicant's [goods], it does not, in any clear or precise way, serve merely to describe applicant's [planning and information management software for magazine makeup and production]." Airco, Inc. v. Air Products & Chemicals, Inc., 196 U.S.P.Q. 832 (T.T.A.B. 1977).

The term IMPOZE does not merely describe Applicant's goods precisely because Applicant does not provide what one would ordinarily associate with the term "impoze" or "impose." In the printing industry, the term "impose" means "to arrange (type or plates) on an imposing stone." *The American Heritage® Dictionary of the English Language*, Fourth Edition, Copyright © 2000. On the other hand, the term "imposition" means "the arrangement of printed matter to form a sequence of pages." *Id.* Thus, the different meanings ascribed to each term in the industry contradict the Examining Attorney's conclusion that the mark IMPOZE is merely descriptive. Further, this fact also renders the Examining Attorney's evidence, which all relates to the term "imposition," irrelevant to whether the term "impose" or "impoze" is merely descriptive. Applicant's software is not used for arranging the type or plates on a imposing stone; rather, Applicant's software is used by publishers to plan and design an entire magazine

layout. Pages can be viewed and arranged on the screen to allow for simple editorial or ad changes. In addition, Applicant's software is capable of creating reports, and the software communicates with the list house, printer and postal service to streamline all of these processes. Thus, when persons see the mark IMPOZE, they are not likely to make the cognitive leap required to intuit the nature of Applicant's goods; IMPOZE is, therefore, suggestive at most.

In Glamorene Products Corp. v. Boyle-Midway, Inc., 188 U.S.P.Q. 145, 165 (S.D.N.Y. 1975) the court held that SPRAY 'N VAC was not merely descriptive of an aerosol rug cleaner, reasoning that "if the consumer must follow a multi-stage reasoning process in order to ascertain what product characteristics the term suggests, the term is suggestive, not descriptive." In this case, the customer most certainly has to follow a multi-stage reasoning process in order to ascertain the characteristics of Applicant's goods that the phrase IMPOZE suggests, and therefore, the term is not merely descriptive.

IMPOZE is no more descriptive than the following marks which were held not merely descriptive and therefore protractible: AUDIO FIDELITY for phonograph records, Audio Fidelity, Inc. v. London Records, Inc., 332 F.2d 577 (C.C.P.A. 1964); CHEW 'N CLEAN for dentifrice, In re Colgate-Palmolive Co., 406 F.2d 1385 (C.C.P.A. 1969); BAC-A-BELT for belt backing materials, Supply Mfg. Co. v. King Trimmings, Inc., 220 F. Supp. 947 (S.D.N.Y. 1963); HANDI WIPES for dusting cloths, In re Colgate-Palmolive Co., 149 U.S.P.Q. 793 (T.T.A.B. 1966); LOC-TOP for container closures in the nature of bottle caps, In re Polytop Corp., 167 U.S.P.Q. 383 (T.T.A.B. 1970).


It is generally recognized that the "suggestive/descriptive dichotomy can require the drawing of fine lines and often involve[s] a good measure of subjective judgment." In re Shutts, 217 U.S.P.Q. at 365. However, the law is well-settled that any doubt should be resolved in favor

of the applicant and that the mark should be published for opposition in accordance with Section 12(a) of the Trademark Act. In re Pennwalt Corp., 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972); accord In re Shutts, 217 U.S.P.Q. at 365; In re Application of Shop-Vac Corp., 219 U.S.P.Q. at 472. Following this principle allows anyone who feels that (s)he would be damaged by the registration to object, without prejudicing the applicant in a borderline case. In re Pennwalt Corp., 17 U.S.P.Q. at 319.

For the foregoing reasons, Applicant respectfully submits that the refusal to register should be withdrawn, and that the application should be approved for publication.

**MICHAEL BEST & FRIEDRICH LLP**  
Attorneys for Quad/Graphics, Inc.

By:

  
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